REMARKS/ARGUMENTS

Claims 1-49 are pending in the application. All claims currently stand rejected. In response to the present Office Action, no claims are amended or cancelled. No new claims are added. Thus, upon entry of this amendment claims 1-49 are pending in the application. No new matter is added.

RESPONSE TO PROVISIONAL NON-STATUTORY DOUBLE PATENTING REJECTION

Claims 1-49 are provisionally rejected based on the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1, 2, and 6-27 of copending Application Serial No. 09/419,571.

The Applicants respectfully submit that the claims of the present application are patentably distinct from those of copending Application Serial No. 09/419,571. The claims of the present application recite a gelled ester composition that includes a hydrophobic, non-polar solvent in addition to a polymer and the ester. The claims also recite a particular viscosity relationship between the gelled ester, the hydrophobic, non-polar solvent, and the resultant composition. On the other hand, the claims of copending application 09/419,571 do not recite a gelled composition that includes both and ester and a hydrophobic non-polar solvent. And there is no disclosure of the claimed viscosity relationship. Since the copending claims do not recite each and every limitation recited in the claims of the present application and because the copending application does not disclose the claimed viscosity relationship, the current claims are patentably distinct over those of copending application 09/419,571. Therefore, the Applicant respectfully requests that the nonstatutory double patenting rejection be withdrawn.

RESPONSE TO REJECTIONS UNDER 35 U.S.C. §103(a)

The Examiner has rejected claims 1-49 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,433,068 to Morrison *et al.* (hereafter referred to as "Morrison" or "the Morrison reference"). Specifically the Examiner stated:

Claims 1-49 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Morrison.

The rejection as set forth under 35 U.S.C. § 103 in Paper No. 5 is deemed proper and is herein repeated.

Applicants' arguments have been fully considered but have been deemed to be not persuasive. Applicants extensively argue the law regarding inherency and conclude that the compositions of Morrison do not necessarily have the recited property. This is not persuasive. The compositions as shown in Morrison are seen to render obvious the instantly claimed composition. Applicants have failed to argue any compositional ingredients as instantly claimed which are not rendered prima facie obvious by the Morrison disclosure. Given that the Morrison patent renders obvious applicants' instantly claimed composition, it is reasonable to presume that the Morrison patent also contains properties which either anticipate or render obvious those as instantly claimed. Applicants have failed to show or allege that such is not the case. The fact of the matter is that Morrison does not teach compositions which are specifically outside of the ranges as claimed. More to the point, the Morrison patent is silent as to the claimed property and as such is seen to be generic to the claimed property. This is to say that the Morrison patent generically teaches compositions which render obvious the instantly claimed composition.

See, Office Action dated December 30, 2003, pages 4-5 (emphasis added).

The applicant has considered the rejection in light of the Examiner's reasoning and respectfully disagrees that *Morrison* renders the claims unpatentable.

THE REJECTION UNDER §103 IS CONTRARY TO THE LAW SINCE OBVIOUSNESS CANNOT BE PREDICATED ON WHAT IS NOT KNOWN.

The recited viscosity relationship is not inherent to the claimed compositions. Example 8 shows a gelled ester that comprises about 86% soybean oil and about 14% Krayton® D1102 polymer has a viscosity of about 18,000 cPs. *Specification, page 53, ll. 12-14.* In Example 8, the hydrophobic, non-polar solvent is Conosol® 340 having a viscosity of about 10.2 cSt (11.8 cPs). Table 10 shows that when the composition is 30% Conosol®/70% gelled ester, the viscosity of the mixture is lower than that of the gelled ester alone. In other words, a mixture having a viscosity that is higher than that of both the gelled ester and the hydrophobic non-polar

solvent is not produced. This data proves that the claimed **viscosity relationship is not necessarily present in a generic disclosure of compositions comprising a gelled ester and a hydrophobic, non-polar solvent**. Thus, as a matter of law, the claimed viscosity relationship is not inherent. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) ("To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and would be so recognized by persons of ordinary skill."). Thus, if Morrison generically discloses the claimed compositions, the properties are not inherent to the Morrison compositions.

Moreover, there is no example of Morrison that discloses the components recited in the rejected claims. For instance Example 1 discloses two gels made from mineral oil and Krayton® polymers. Examples 2 and 3 disclose gels made from mineral oil, Krayton® polymer and titanium dioxide. Example 4 is a gel made from mineral oil, Krayton polymer and talc. Example 5 relates to mineral oil gels to which talc and a surfactant have been added. Example 6 includes 50% gelled mineral oil (presumably mineral oil and Krayton® polymer) and 50% zinc oxide. Thus, the gels of Examples 1-6 do not include both an ester and a hydrophobic non-polar solvent.

Example 7 is a gel made from mineral oil, Krayton® polymer, isohexadecane and zinc oxide. Example 8 is a gel made from mineral oil, Krayton® polymer, polyisobutene and zinc oxide. Examples 9-11 are gels made from mineral oil, Krayton polymer mineral oil, Krayton® polymer and either isohexadecane, isododecane, or polydecene, respectively, along with zinc oxide. Mineral oil is a petroleum distillate that is well known to be a hydrophobic non-polar solvent. Thus, the gels of Example 7-11 include two different hydrophobic, nonpolar solvents. None of these examples disclose a gel comprising an ester and a hydrophobic non-polar solvent.

Even if some of the alternative components enumerated in Column 4 of Morrison could be selected and combined in a manner that provides a composition that includes a gelled ester and a hydrophobic, non-polar solvent, nothing in Morrison discloses the claimed viscosity relationship. In fact, the Examiner has stated on the record that the disclosure of Morrison does not disclose the claimed viscosity relationship:

> "**While the specific visc sity is not disclosed within [Morrison]** it is seen to be a limitation which is either inherently anticipated or rendered obvious from the disclosure of this reference. This reference teaches the same polymers as well as solvents which fall within the

> scope of the description of the claims. It is reasonable to presume that the same ingredients in combination with one another would have the same properties. Applicants have failed to show or allege that such is not the case."

See, Office Action of July 7, 2003, pages 2-3 (emphasis added).

But the mere absence from a reference of an explicit requirement cannot reasonably be construed as an affirmative statement that the requirement is in the reference. *In re Evanega*, 4 USPQ2d 1249 (Fed. Cir. 1987). **And it is well-established that obviousness cannot be predicated on what is not known, even where properties may be inherent**. *Application of Spormann*, 53 C.C.P.A. 1375 at 1380, 363 F.2d 444 at 448. Thus, Morrison fails to establish a prima facie case of obviousness with respect to the rejected claims.

BECAUSE THE REJECTION IS BASED ON THE SELECTIVE CULLING OF THE GENERIC TEACHINGS OF MORRISON THE REJECTION IS BASED ON HINDSIGHT

The Applicants submit that the rejection under 35 U.S.C. §103 is improper because it is based on impermissible hindsight. Morrison discloses a vast number of generically disclosed compositions, including optional language stating that an ester may be included along with other hydrocarbons. But, **specific statements that in the abstract may appear to suggest a limitation are insufficient where there is no specific understanding within the knowledge of one skilled in the that would motivate one with no knowledge of the Applicants' disclosure to make the claimed invention**. *In re Kotzab*, 54 USPQ2d 1308 (Fed. Cir. 2000). Since the Examiner has admitted that the Morrison reference fails to disclose the claimed viscosity relationship and none of the examples of Morrison include an ester, it cannot provide one skilled in the art with a motivation to select those compositions that include the ester along with a hydrophobic, non-polar solvent and have the recited viscosity relationship. Consequently, Morrison cannot provide specific knowledge in the art that such species would be desirable or have the claimed properties. This is especially true where the Applicant's disclosure shows that the properties are not inherent. Thus, the rejection based on Morrison is based on an impermissible hindsight determination of obviousness.

For all of the reasons discussed above the Applicants respectfully submit that Morrison fails to establish a prima facie case of obviousness with respect to the rejected claims. Moreover, the Applicants respectfully submit that this showing that the claimed properties are not inherent

in the prior art compositions rebuts any *prima facie* case of obviousness. *In re Best at 1255* (emphasis added).

CONCLUSION

The Applicants have addressed all of the Examiner's rejections. In conjunction with the arguments above, the Applicants believe that the application is now in condition for allowance and respectfully request that the Examiner grant such an action. If any questions or issues remain, the resolution of which the Examiner feels will be advanced by a conference with the Applicants' attorney, the Examiner is invited to contact the attorney at the number noted below.

Should there be any additional fees required, please charge such additional fees to Deposit Account 10-0447, reference 42133-00009USP1 (ABDON).

Respectfully submitted,

JENKENS & GILCHRIST
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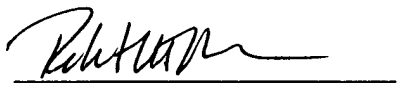

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